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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/511,849	11/17/2004	Mikael Jaatinen	2493-21	6264
23117	7590	10/04/2007		
NIXON & VANDERHYE, PC 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON, VA 22203			EXAMINER NICKERSON, JEFFREY L	
			ART UNIT 2109	PAPER NUMBER
			MAIL DATE 10/04/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/511,849

**Applicant(s)**

JAATINEN, MIKAEL

**Examiner**

Jeffrey Nickerson

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 November 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 November 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>17 November 2004, 28 June 2005</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This communication is in response to Application No. 10/511,849 filed on 17 November 2004. The preliminary amendment, which provides change to claims 7-9, 11-12, 19-21, 23-24, is hereby acknowledged. Claims 1-24 have been examined.

#### ***Information Disclosure Statement***

2. The information disclosure statement (IDS) submitted on 28 June 2005 was filed after the filing date of the national stage application on 17 November 2004. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the examiner is considering the information disclosure statement.

3. The search reports are not considered prior art, as they are mere indications of relevant prior art and occur after the invention was invented. The references listed in an international search report are generally considered and said references should be listed individually on the IDS if applicant explicitly wishes them to be considered. As such, the ISRs are never considered as prior art in and of themselves.

#### ***Specification***

4. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

5. The abstract of the disclosure is objected to because of the phrase "The present invention describes" in the first sentence and the phrase "In the solution according to the present invention" in the second sentence. Both of these phrases fall into the category of implied phraseology and should be removed. Correction is required. See MPEP § 608.01(b).

6. The disclosure is objected to because of the following informalities: incorrect grammar and spelling. On page 3A of the applicant submitted specification (Pre-Grant publication: [0012]), lines 11-12 have incorrect spelling and grammar. The word

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“establish” is spelled incorrectly and the phrase “of a call broker equipment” should be changed to “of call broker equipment.”

Appropriate correction is required.

### ***Claim Objections***

7. Claims 1, 13, 14 and 16 are objected to because of the following informalities: incorrect spelling or grammar.

Regarding claim 1, line 2 of claim 1 spells the word “network” with a hyphen and line 9 of claim 1 spells the word “address” with a hyphen, both of which are incorrect.

Appropriate correction is required.

Regarding claim 13, lines 14 and 16 contain the phrase “a originating party A”, which is incorrect grammar. The correct phrase would be “an originating party A”, however, the examiner recommends changing the phrase to “the originating party A.”

Appropriate correction is required.

8. Claim 1, 10, and 13 are objected to because of the following informalities: Lack of antecedent basis for a limitation in the claim, or an error with antecedent basis for a limitation in the claim.

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Regarding claims 1 and 13, they recite the limitation "the regular subscriber identity" in line 7 of the each claim. There is insufficient antecedent basis for this limitation in the claim.

Appropriate correction is required.

Regarding claims 1 and 13, they recite the limitation "an anonymous communication path" in line 17 of claim 1 and line 18 of claim 13. There is sufficient antecedent basis for this limitation in the claim, and it is not being used. The examiner recommends changing this phrase to "the anonymous communication path."

Appropriate correction is required.

Regarding claims 1 and 13, they recite the limitation "the subscriber identity" in lines 15 and 20 of claim 1 and lines 16 and 21 of claim 13. This phrase could be referring to the regular subscriber identity or the anonymous subscriber identity, which makes the antecedent basis for the limitation ambiguous. For purposes of further examination the examiner will assume the phrases are referring to the regular subscriber identity of the party mentioned in the sentence. Line 15 of claim 1 and 16 of claim 13 do not specify which party's identifier is being suppressed. For purposes of further examination these lines will be referring to party A's subscriber identity.

Appropriate correction is required.

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Regarding claims 10 and 13, they recite the limitation "the service" in line 2 of both claims. There is insufficient antecedent basis for this limitation in the claim. For purposes of further examination the examiner will treat the limitation to be "a service."

Appropriate correction is required.

9. Claim 1 is objected to because of the following informalities: a repetitive transition statement at the end of the preamble of the claim.

Regarding claim 1, it states 'the method being characterized in that the method comprises the steps of', which is redundant. The examiner asks the applicant to eliminate this phrase and simply state 'comprising the steps of:' as the transition phrase of the preamble.

Appropriate correction is required.

10. Claims 8 and 20 are objected to because of the following informalities: art related definition confliction.

Regarding claims 8 and 20, the applicant states the address is announced "in Television." The singular term "television" is commonly viewed as the physical television set in which television broadcasts are received and viewed at the end user's system. The examiner assumes that the applicant is referring to announcing the address over a television network (i.e. the television broadcasts) so that they may later

be received and handled by television sets. For purposes of further examination the examiner will read the limitation to be "announces the received temporary SIP address over television signals."

Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

11. Claims 1-7, 9-19, and 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Winnett (WO 01/31903 A1), and further in view of Gudjonsson (US 6,564,261 B1).

The applied reference (Gudjonsson) has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing



that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(I)(1) and § 706.02(I)(2).

Regarding claim 1, Winnett teaches a method for providing a subscriber with an anonymous subscriber identity (unique identifier/caller identifier), for use in an IP communications network (Winnett: pg 4, line 11) having an originating party A (Winnett: Figure 1, item 110) and a terminating part B (Winnett: Figure 1, item 120) connected to the network (Winnett: Figure 1, items 160, 170, and 180), comprising the steps of:

the terminating party B requesting a temporary address (unique identifier) to be used as an anonymous subscriber identity (Winnett: pg 6, line 25 – pg 7, line 2 specify both parties initiate the voice call process which results in a request for voice channels to be reserved and an assignment of a unique identifier);

the IP communications network reserving a temporary address to which a regular subscriber identity of the terminating party B is associated (Winnett: pg 7, lines 1-2 specify generating a unique identifier to be assigned to the call, implying it is associated to the parties);

an application server (chat room server in combination with voice call server) providing the temporary address to the terminating party B (Winnett: pg 7, lines 4-5 specify the parties are informed);

the terminating party B announcing the received address in an open forum (chat room) (Winnett: pg 1, lines 21-23 specify that announcing identifiers is a problem with

the prior art and Winnett's invention circumvents this requirement by having the voice call server handle unique identifier distribution; see pg 7, lines 6-8);

the originating part A initiating an anonymous communication path towards the temporary address of the terminating party B (Winnett: pg 7, lines 14-18);

the originating party A suppressing the regular subscriber identity in the communication path setup (Winnett: pg 7, lines 17-19 specify the voice call server prompts the originating party for their account number, password, and the caller identifier; pg 7, lines 24-25 specify the server merely informs party B that the call is ready for completion, implying that the account information is suppressed);

the IP communications network establishing an anonymous communication path between the originating party A and the terminating party B for anonymous communication between two parties using any type of bearer available for communication between two parties in an IP based network (Winnett: abstract; pg 8, lines 6-9);

and using the subscriber identity of the terminating party B associated with the temporary address (Winnett: pg 7, lines 18-19; pg 8, lines 1-2 specify association with party B).

Winnett does not teach wherein the temporary address is based on SIP.

Gudjonsson, in a similar field of endeavor, teaches wherein the anonymous communication between users is done using SIP (Gudjonsson: col 9, lines 8-14).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teachings of Gudjonsson for using SIP as the

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communication method. The teachings of Gudjonsson, when implemented in Winnett's system, will enable one of ordinary skill in the art to use an IETF standard for communication. One of ordinary skill in the art would be motivated to utilize the teachings of Gudjonsson in the Winnett system because "SIP is in the process of becoming the IETF standard and has been positioned as the successor of SS7 in IP based networks." (Gudjonsson: col 2, lines 24-29).

Regarding claim 2, the Winnett/Gudjonsson system teaches wherein the temporary SIP address is requested via the Internet (Winnett: pg 6, lines 29-30 specify the request is made over the private network; pg 5, lines 13-14 specify the private network could be the Internet).

Regarding claim 3, the Winnett/Gudjonsson system teaches wherein the temporary SIP address is requested via an SMS-interface (Gudjonsson: abstract specifies communication via SMS).

Regarding claim 4, the Winnett/Gudjonsson system teaches wherein the temporary SIP address is requested via a WAP-interface (Gudjonsson: col 7, lines 52-60 specify that the communication network could employ WAP).

Regarding claim 5, the Winnett/Gudjonsson system teaches wherein the terminating party B requests the temporary SIP address by dialing a number in the IP

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communications network (Gudjonsson: col 1, lines 23-29 specify the communication network could use dialing numbers).

Regarding claim 6, the Winnett/Gudjonsson system teaches wherein the terminating party B requests the temporary SIP address via an email-interface (Gudjonsson: col 1, lines 18-20 specify emailing for communication).

Regarding claim 7, the Winnett/Gudjonsson system teaches wherein the terminating party B requests several temporary SIP addresses (Winnett: pg 8, lines 19-22 specify that more than two parties may be bridged, implying that more than one unique identifier is used).

Regarding claim 9, the Winnett/Gudjonsson system teaches wherein the terminating party B announces the received temporary SIP address in a restricted open forum (Winnett: pg 7, lines 17-18 specifies an account and password, implying it is restricted).

Regarding claim 10, the Winnett/Gudjonsson system teaches wherein the restricted open forum is the service providing the temporary SIP address (Winnett: pg 6, line 25 – pg 7, line 5 specify that the chat room server in combination with the voice call server provide the services).

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Regarding claim 11, the Winnett/Gudjonsson system teaches wherein the terminating party B terminates the temporary SIP address (Winnett: pg 8, lines 7-8 specify the call is dropped when a party hangs up, implying that the unique identifier is no longer used).

Regarding claim 12, the Winnett/Gudjonsson system teaches wherein the use of a temporary SIP address is disabled for a time period (Winnett: pg 8, lines 8-9 specify the call is dropped when a time limit is expired, implying that the unique identifier is disabled for the period of time after expiration).

Regarding claim 13, this arrangement claim comprises limitations substantially similar to that of claim 1 and the same rationale of rejection is used, where applicable.

Regarding claim 14, this arrangement claim comprises limitations substantially similar to that of claim 2 and the same rationale of rejection is used, where applicable.

Regarding claim 15, this arrangement claim comprises limitations substantially similar to that of claim 3 and the same rationale of rejection is used, where applicable.

Regarding claim 16, this arrangement claim comprises limitations substantially similar to that of claim 4 and the same rationale of rejection is used, where applicable.

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Regarding claim 17, this arrangement claim comprises limitations substantially similar to that of claim 5 and the same rationale of rejection is used, where applicable.

Regarding claim 18, this arrangement claim comprises limitations substantially similar to that of claim 6 and the same rationale of rejection is used, where applicable.

Regarding claim 19, this arrangement claim comprises limitations substantially similar to that of claim 7 and the same rationale of rejection is used, where applicable.

Regarding claim 21, this arrangement claim comprises limitations substantially similar to that of claim 9 and the same rationale of rejection is used, where applicable.

Regarding claim 22, this arrangement claim comprises limitations substantially similar to that of claim 10 and the same rationale of rejection is used, where applicable.

Regarding claim 23, this arrangement claim comprises limitations substantially similar to that of claim 11 and the same rationale of rejection is used, where applicable.

Regarding claim 24, this arrangement claim comprises limitations substantially similar to that of claim 12 and the same rationale of rejection is used, where applicable.

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12. Claims 8 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Winnett (WO 01/31903 A1) and Gudjonsson (US 6,564,261 B1), and further in view of Graziani (US 2001/0051982 A1).

Regarding claim 8, the Winnett/Gudjonsson system teaches wherein the terminating party B announces the received temporary SIP address into an open forum (chat room) (Winnett: pg 1, lines 21-23 specify announcing into a chat room; Gudjonsson: col 9, lines 8-14 specify using SIP).

The Winnett/Gudjonsson system does not teach wherein the communication is over television signals.

Graziani, in a similar field of endeavor, teaches wherein the chat room data is in a television broadcast (Graziani: [0011]).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teachings of Graziani for using a television signal for transmitting chat room data. The teachings of Graziani, when implemented in the Winnett/Gudjonsson system, will enable one of ordinary skill in the art to participate in a chat room via television signals. One of ordinary skill in the art would be motivated to utilize the teachings of Graziani in the Winnett/Gudjonsson system to handle when "a user does not have an on-line service provider, but wishes to participate in the chat." (Graziani: [0012]).

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Regarding claim 20, this arrangement claim comprises limitations substantially similar to that of claim 8 and the same rationale of rejection is used, where applicable.

### ***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Rochkind (US 6,161,129) discloses a system for substituting alias addresses for real addresses in order to maintain confidentiality of users.
- b. Martin (US 6,931,114 B1) discloses a system and method for implementing a chat service over a telephone network that can handle private conversations.
- c. Desimone (US 6,175,619 B1) discloses a system and method for providing anonymous voice communication over a telephone network using a call broker.

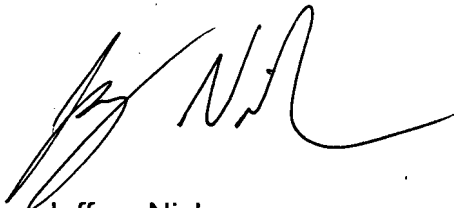
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey Nickerson whose telephone number is 571-270-3631. The examiner can normally be reached on M-Th, 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beatriz Prieto can be reached on 571-272-3902. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Jeffrey Nickerson  
TC 2100  
Patent Examiner  
September 17, 2007

  
**BEATRIZ PRIETO**  
SUPERVISORY PATENT EXAMINER